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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR _s	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/239,414	01/28/1999	JAMES S. UMSTETTER	99P744US	6061

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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

TRAN, CON P

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 01/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/239,414

Applicant(s)

UMSTETTER ET AL.

Examiner

Con P. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 4, 7-8, 17, and 19-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522.

Regarding **claim 1**, Tombetti teaches a method for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising steps of:

enabling a telephone to store call-related data in memory (360) located within the telephone (see col. 8, lines 29-35);

receiving first call-related data at the telephone (see col. 5, lines 50-65 and col. 3, lines 32-49);

recognizing that the first call-related data is to be stored in memory (see col. 8, lines 29-35);

determining, within the telephone, whether the first call-related data will be stored in the telephone memory or the computer memory (see col. 3, lines 32-49 and col. 5, lines 50-65); and

storing the first call-related data in the telephone memory or the computer memory based upon the determination (see col. 3, lines 32-49; col. 5, lines 50-65 and col. 8, lines 29-35);

enabling a computer to store the call-related data in memory located within the computer (see col. 3, lines 32-49); .

However, Tombetti reference does not explicitly disclose to alternatively store the call-related data in memory located within the computer.

In the same field of endeavor, Sells et al. teaches to alternatively store (see Fig. 1, 2, 3, and respective portions of the specification) the call-related data in memory located within the computer (see col. 3, lines 59-65) in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti reference a step to alternatively store the call-related data in memory located within the computer as taught by Sells et al. since such combination would have transferred control of the telephone line to the appropriate telephony application program as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 4**, Tombetti further teaches the method as claimed in claim 1 (see Fig. 2, 3, 5, and respective portions of the specification), wherein the telephone is enabled to perform telephone functions independently of the computer (see col. 3, lines 32-49 and col. 5, lines 50-65).

Regarding **claim 7**, Tombetti in view of Sells et al. teaches a method as claimed in claim 1 further including steps of:

enabling a first processor (152) located within the telephone to process data received at the telephone (see Tombetti, Fig. 3, col. 6, lines 10-18);

enabling a second processor located within the computer to process data received at the telephone (see Tombetti, col. 3, lines 32-49);

recognizing that the first call-related data received at the telephone is to be processed (see Sells, col. 5, lines 5-18); and

determining, within the telephone, whether the first call-related data will be processed by the first processor or the second processor (see Tombetti, col. 3, lines 32-49 and col. 5, lines 50-65), the telephone thereby controlling the first call-related to which of two structurally separate components will perform processing thereon.

Regarding **claim 8**, Sells et al. teaches the method as claimed in claim 1 (see Fig. 1, 4, and respective portions of the specification) further including a step of utilizing a processor of the computer to process at least a portion of the first call-related data in response to instructions from the telephone (see col. 4, line 65 - col. 5, line 14).

Regarding **claim 17**, Tombetti teaches a method for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising steps of:

enabling a first processor (152) resident in a telephone to process data received at the telephone (see col. 6, lines 10-18);

enabling a second processor resident in a computer to process data received at the telephone (see col. 3, lines 32-49);

receiving call-related data at the telephone (see col. 5, lines 50-65 and col. 3, lines 32-49);

determining, using automated processing capabilities of the telephone (col. 6, lines 34-40), whether the call-related data will be processed in the first processor or the second processor (see col. 3, lines 32-49, and col. 5, lines 50-65) including basing said determination upon automated processing performed by the telephone; and

processing the call-related data in either the telephone or the computer based upon the determination (see col. 3, lines 32-49; col. 5, lines 50-65) made using the automated capabilities (col. 6, lines 34-40).

However, Tombetti reference does not explicitly disclose a step of recognizing that the call-related data required further processing.

In the same field of endeavor, Sells et al. teaches a step (see Fig. 1, 5, and respective portions of the specification) of recognizing that the call-related data required

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further processing (see col. 5, lines 5-18) in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti reference a step of recognizing that the call-related data required further processing as taught by Sells et al. since such combination would have transferred control of the telephone line to the appropriate telephony application program as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 19**, Tombetti in view of Sells et al. teaches a method as claimed in claim 18 (see Fig. 2, 3, 5, and respective portions of the specification) including steps of:

enabling the telephone to store data received at the telephone in memory located within the telephone (see Sells, col. 8, lines 29-35);

enabling the computer to store data received at the telephone in memory (360) located within the computer (see Sells, col. 3, lines 39-65 and col. 4, lines 48-54);

recognizing that the received call-related data is to be stored in memory (see Sells, col. 4, lines 3-6);

determining, within the telephone, whether the call-related data will be stored in the telephone memory or the computer memory (see Tombetti, col. 3, lines 32-49 and col. 5, lines 50-65); and

storing the call-related data in the telephone memory or the computer memo based upon the determination (see Tombetti, col. 3, lines 32-49; col. 5, lines 50-65 and col. 8, lines 29-35).

Regarding **claim 20**, Tombetti further teaches the steps of determining are performed by an application programming interface residing within the telephone (see col. 4, lines 16-35).

3. **Claims 2-3** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522, and further in view of Dunn et al. U.S. Patent 5,495,528.

Regarding **claim 2**, Sells et al. further teaches a step of establishing (see Fig. 1 and respective portions of the specification) a direct data connection between the telephone and the computer (see col. 3, lines 53-58). However, Tombetti in view of Sells et al. does not explicitly show the telephone and the computer being structurally separate components.

Thus one of ordinary skill would have been motivated to seek a step of establishing a direct data connection in which the telephone and the computer being structurally separate components as step taught by Sells. Such method would have been any known telephone control interface such as one of Dunn et al. in the same field of endeavor.

Dunn et al. teaches a step of establishing (see Fig. 1 and respective portions of the specification) a direct data connection between the telephone and the computer, the telephone and the computer being structurally separate components (see col. 4, lines 4-25).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to include within the Tombetti in view of Sells et al. a step of establishing a direct data connection between the telephone and the computer, the telephone and the computer being structurally separate components as taught by Dunn et al. in col. 4, lines 4-25 in order to selectively provide a computer control to a digital feature telephone as suggested by Dunn et al. on column 2, lines 44-45.

Regarding **claim 3**, Sells et al. further teaches the method as claimed in claim 2 (see Fig. 1 and respective portions of the specification) wherein the telephone and the computer are located within a common workspace, the step of establishing the direct data connection being independent of providing connectivity for receiving the first call-related data (see col. 3, lines 47-52).

4. **Claims 5-6, 9 and 18** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Sells et al. U.S. Patent 5,471,522, and further in view of Kikinis et al. U.S. Patent 5,799,068.

Regarding **claim 5**, Tombetti in view of Sells et al. teaches a method as claimed in claim 1 wherein the step of determining includes steps of:

monitoring storage availability within the telephone memory (see Tombetti col. 8, lines 1-8).

However, Tombetti in view of Sells et al. does not explicitly disclose:

comparing the monitored storage availability to a storage threshold that is related to the telephone memory; and

storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded.

In the same field of endeavor, Kikinis et al. teaches steps of (see Fig. 3, 13, 14, and respective portions of the specification):

comparing the monitored storage availability to a storage threshold that is related to the telephone memory (see col. 2, lines 50-64 and col. 16, lines 11-21); and

storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (see col. 2, lines 50-64 and col. 16, lines 11-21);

in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Sells et al. reference steps of:

comparing the monitored storage availability to a storage threshold that is related to the telephone memory (see col. 2, lines 50-64 and col. 16, lines 11-21); and

storing the first call-related data in the computer memory when the storage threshold related to the telephone memory is exceeded (see col. 2, lines 50-64 and col. 16, lines 11-21);

as taught by Kikinis et al. since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

Regarding **claim 6**, Kikinis further teaches a step (see Fig. 13, and respective portions of the specification) of retrieving call-related data from the computer to the telephone in response to signals from the telephone (see col. 12, lines 25-38).

Regarding **claim 9**, Kikinis further teaches a step (see Fig. 3, and respective portions of the specification) of establishing a data connection between the telephone and the computer by connecting the telephone separately to a telephone network and to the computer (see col. 5, lines 54-61).

Regarding **claim 18**, Tombetti in view of Sells et al. teaches a method as claimed in claim 17. Sells et al. further teaches the computer are structurally separate components (Fig. 1; col 3, lines 47-58).

However, Tombetti in view of Sells et al. does not explicitly disclose:

a step of establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions

independently of the computer.

In the same field of endeavor, Kikinis et al. teaches a step of (see Fig. 1 and respective portions of the specification) establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions independently of the computer (see col. 3, lines 47-52) in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Sells et al. reference steps of:

establishing a direct data connection between the telephone and the computer, wherein the telephone and the computer are located within a common workspace and wherein the telephone is configured to perform telephone functions independently of the computer (see col. 3, lines 47-52) as taught by Kikinis et al. since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

5. **Claims 10 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068.

Regarding **claim 10**, Tombetti teaches an apparatus for extending a telephone's capability (see Fig. 2, 3, 5, and respective portions of the specification) comprising:

means (communication module 156), located within the telephone, for receiving data from a telephone network (see col. 7, lines 21-25);

means (additional memory 360), located within the telephone, for storing the data received from the telephone network (see col. 8, lines 29-35);

However, Tombetti reference does not explicitly disclose:

means, operatively associated with the means for receiving, for enabling the telephone to automatically determine without user input whether the data received at the telephone will be maintained at the telephone or transferred to a computer; and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer.

In the same field of endeavor, Kikinis et al. teaches apparatus (see Fig. 3, 13, 14, and respective portions of the specification) comprising:

means, operatively associated with the means for receiving, for enabling the telephone (smart phone) to automatically determine without user input (col. 17, lines 54-67) whether the data received at the telephone will be maintained at the telephone or transferred to a computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21); and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21).

in order to add digital telephone capability to the computer (see col. 3, lines 20-21).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti reference apparatus comprising:

means, operatively associated with the means for receiving, for enabling the telephone (smart phone) to automatically determine without user input (col. 17, lines 54-67) whether the data received at the telephone will be maintained at the telephone or transferred to a computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21); and

means, operatively associated with the telephone, for transferring the data between the telephone and the computer (see col. 2, lines 50-64 and col. 15, line 60 - col. 16, line 21), as taught by Kikinis et al., since such combination would have added digital telephone capability to the computer as suggested by Kikinis et al. in column 3, lines 20-21.

Regarding **claim 16**, Tombetti in view of Kikinis et al. further teaches an apparatus as claimed in claim 10 including:

means (process module 152), located within the telephone, for processing the data received from the telephone network (see Tombetti, Fig. 3, col. 6, lines 10-18);

means (i.e., processing data), located within the computer, for processing the data received from the telephone (see Tombetti, col. 3, lines 32-49); and

means (ASIC 24), located within the telephone, for determining whether the data received at the telephone from the telephone network will be processed within

the telephone processing means or the computer processing means (see Kikinis col. 6, lines 29-38).

6. **Claims 11 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068 and further in view of Sells et al. U.S. Patent 5,471,522.

Regarding **claim 11**, Tombetti in view of Kikinis et al. teaches an apparatus as claimed in claim 10. However, Tombetti in view of Kikinis et al. does not explicitly disclose:

means, located within the computer, for storing the data received from the telephone; and

means, located within the telephone, for determining whether data received at the telephone from the telephone network will be stored within the telephone storage means or the computer storage means.

In the same field of endeavor, Sells et al. teaches an apparatus including (see Fig. 1, 2, 3, and respective portions of the specification):

means (memory subsystem 31), located within the computer, for storing the data received from the telephone (see col. 3, lines 59-65); and

means (DSP software 120), located within the telephone, for determining whether data received at the telephone from the telephone network will be stored within

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the telephone storage means or the computer storage means (see col. 3, lines 59-65 and col. 4, lines 48-54);

in order to transfer control of the telephone line to the appropriate telephony application program (see col. 8, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti in view of Kikinis et al. reference an apparatus including means (memory subsystem 31), and means (DSP software 120), as taught by Sells et al., since such combination would have transferred control of the telephone line to the appropriate telephony application program as suggested by Sells et al. in column 8, lines 59-62.

Regarding **claim 12**, Sells et al. further teaches an apparatus as claimed in claim 10 (see Fig. 1 and respective portions of the specification) wherein the telephone is connected separately to the telephone network and the computer (see col. 3, lines 47-52).

7. **Claims 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tombetti U.S. Patent 6,021,187 in view of Kikinis et al. U.S. Patent 5,799,068 further in view of Sells et al. U.S. Patent 5,471,522, and further in view of Yeh et al. U.S. Patent 6,366,653.

Regarding **claim 13**, Tombetti in view of Kikinis, and further in view of Sells teaches an apparatus as claimed in claim 12.

However, the Tombetti, Kikinis, and Sells in combination fails to clearly teaches an apparatus wherein the computer lacks computer telephony capability.

In the same field of endeavor, Yeh et al. teaches a computer lacks computer telephony capability (see col. 1, lines 30-34) in order to provide various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware (see col. 1, lines 50-53).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included within the Tombetti, Kikinis, and Sells in combination an apparatus wherein the computer lacks computer telephony capability as taught by Sells et al. since such combination would have provided various telephone functions on the computer with user friendly interfaces using programmable software, and computer and telephone hardware as suggested by Yeh et al. in column 1, lines 50-53.

Regarding **claim 14**, Kikinis et al. further teaches an apparatus wherein the means for enabling is located within the telephone (see col. 2, lines 50-64 and col. 15, line 60 – col. 16, line 21).

Regarding **claim 15**, Kikinis et al. further teaches an apparatus wherein the means for enabling includes an application programming interface resident within the telephone (see col. 2, lines 50-64 and col. 15, line 60 – col. 16, line 21).

Response to Arguments

8. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new grounds of rejection.

Conclusion

9. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.

Certificate of Mailing

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Typed or printed name of person signing this certificate:

Signature: _____

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Signature: _____

Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Con P. Tran whose telephone number is (703) 305-2341. The examiner can normally be reached on M - F (8:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W. Isen can be reached on (703) 305-4386. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Customer Service Office at telephone number (703) 306-0377.


FORESTER W. ISEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

cpt CPT
December 30, 2002